

Remarks/Arguments

The foregoing amendments to the claims are of formal nature, and do not add new matter. Prior to the present amendment, claims 39-51 were pending in this application and were rejected on various grounds. Claim 48 has been canceled without prejudice and claims 39-44 has been amended. The rejection to the presently pending claims are respectfully traversed.

Priority

Applicants rely on the proinflammatory cell infiltration assay (Example 77) to establish patentable utility for the polypeptide PRO331. These results were first disclosed in international application PCT/US98/19437, filed 17 September, 1998 to which priority is claimed in this application. Support is present in the present application in Example 77, page 210, lines 22 onwards. Accordingly, the present application is entitled to the effective filing date of 17 September, 1998.

Claim Rejections – 35 USC § 112, second paragraph

Claims 39-44, 47, 48, 50 and 51 were rejected under 35 U.S.C. §112, second paragraph, allegedly, as being indefinite for reciting "extracellular domain, part (c) and also extracellular domain, lacking its associated signal sequence, part (d)."

The foregoing amendments to the above claims wherein references to "lacking its associated signal peptide" have been deleted, are believed to overcome this rejection. Applicants note that PRO331 polypeptides have a transmembrane domain (see specification, Figure 104). Accordingly, recitation of "extracellular domain" is definite and this rejection should be withdrawn.

Claim Rejections – 35 USC § 112 Enablement and Written Description

Claims 39-44, 47, 48, 50 and 51 were rejected under 35 U.S.C. §112, first paragraph, since allegedly, "the specification does not reasonably provide enablement for a polypeptide not identical to at least the mature form of SEQ ID NO:292 which does not have a specific activity

limitation" and says that thus, one skilled in the art would not know how to use the invention commensurate in scope with these claims. The Examiner also alleges that the specification does not convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Present claim amendments recite polypeptides "capable of inducing an immune or inflammatory response." Support for this recitation is found in Example 77 (page 210, lines 22) which describes a dye-based proinflammatory cell infiltration assay in which PRO331 induces mononuclear cell, eosinophil and PMN infiltration into the site of injection of this peptide/protein into an animal. The Examiner has acknowledged that the results of Example 77 provide the skilled artisan with guidance on how to use the polypeptide (Office action, page 6, line 12-14).

In view of the present claim amendments, the claims are now drawn to a genus of polypeptides defined both by sequence and functional identity. Based on the information disclosed in the specification and that which was available in the art, one skilled in the art knew how to practice the claimed invention, at the effective priority date of this application, without undue experimentation. As the M.P.E.P. states, "The fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation. *In re Certain Limited-charge cell Culture Microcarriers*, 221 USPQ 1165, 1174 (Int'l Trade Comm'n 1983), *aff. sub nom., Massachusetts Institute of Technology v A.B. Fortia*, 774 F.2d 1104, 227 USPQ 428 (Fed. Cir. 1985) M.P.E.P. 2164.01. One of skill in the art also knew that the Applicants had possession of the claimed molecules at the time of filing.

Hence, the Examiner is respectfully requested to reconsider and withdraw the present rejection.

Claim Objections

Claims 45, 46 and 49 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all limitations of the base claim and intervening claims. Applicants respectfully traverse.


Claims 45, 46 and 49 depend on Claim 44 which has presently been amended to delete references to "lacking its associated signal peptide" and is definite for reciting "extracellular domain" since PRO331 has a transmembrane domain (see specification, Figure 104). Thus, the above claims no longer depend on a rejected claim and accordingly, this objection should be withdrawn.

The present application is believed to be in *prima facie* condition for allowance, and an early action to that effect is respectfully solicited.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 08-1641 (Attorney Docket No.: 39780-1618P2C44). Please direct any calls in connection with this application to the undersigned at the number provided below.

Respectfully submitted,

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